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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/021,660	02/10/1998	MARGARET H. BARON	1874/110	4751

28120 7590 07/18/2002

ROPES & GRAY
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

EXAMINER

KAUFMAN, CLAIRE M

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 07/18/2002

38

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/021,660

Applicant(s)

BARON ET AL.09021660

Examiner

Claire M. Kaufman

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply ^{would} ~~has~~ overcome the following rejection(s): based on claims 74 and 75.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 57-75 and 82-113.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Continuation of 2. NOTE: "functionally equivalent" and "naturally occurring" raise new issues under 35 USC 112, 1st and 2nd paragraphs.

Continuation of 5. does NOT place the application in condition for allowance because:

Applicants argue that the objection to the specification and rejection of claims 57-75 and 82-113 under 35 USC 112, first paragraph, because of improper incorporation of reference has no legal merit and should be withdrawn. The argument has been fully considered, but is not persuasive. Applicants are directed to discussion of *In re de Seversky*, 474 F.2s 671, 177 SUPQ 144 (CCPA) cited in previous Office action, paper #34, middle of page 3, in which it was held that incorporation is improper unless particular attention is direct to specific portions of the referenced document where the subject matter being incorporated may be found. See also *Ex parte Raible* (BPAI) 8 USPQ2d 1709, 1711 where *Seversky* is also cited:

The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an *incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found.*

To clarify Applicants' dismissal of *In re Hawkins* as not applicable to the instant situation, *Hawkins* was previously cited as an example of permissible incorporation of reference even though it lack reference to line and column number. That is, the incorporation by reference was of a material with a very specific chemical structure. This is in contrast to the attempt to incorporate by reference in the instant application by reference to general, vague and widely encompassing concepts (see previous Office action, paper #36, third and fourth paragraph of page 3).

Applicants cite (middle of page 9 of response) claims 57-75 and 82-113 as rejected as not being enabled under 35 USC 112, first paragraph. Not all claims were rejected, but only claims 57, 58, 60-75, 82, 83, 85-96 and 99-113 were rejected.

Applicants' arguments for the rejection of claims as not enabled under 35 USC 112, first paragraph, are not persuasive for reasons of record. Further, use of the term "naturally occurring" is not necessarily equivalent to saying, for example (claim 59), "an Indian hedgehog protein" (see previous Office action, paper #34, last paragraph of page 2), and could be subject to

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a rejection under 35 USC 112, second paragraph, were the proposed amendment after final to have been entered.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (703) 308-6564.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.

Claire M. Kaufman, Ph.D.



Patent Examiner, Art Unit 1646

July 17, 2002



**LORRAINE SPECTOR
PRIMARY EXAMINER**